



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,088	04/15/2004	David Sperduti	H28240	7165
128 7590 11/13/2009 HONEYWELL INTERNATIONAL INC. PATENT SERVICES 101 COLUMBIA ROAD P O BOX 2245 MORRISTOWN, NJ 07962-2245				
EXAMINER				
ADE, OGER GARCIA				
ART UNIT		PAPER NUMBER		
3687				
MAIL DATE		DELIVERY MODE		
11/13/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/825,088

Applicant(s)

SPERDUTI ET AL.

Examiner

GARCIA ADE

Art Unit

3687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 21-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 21-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on **08.13.2009** has been entered.

***Response to Amendment***

2. Applicants' "Request for Continued Examination" filed on **August 13, 2009** has been considered.

Applicants cancelled **claims 9-20**, and added new **claims 21-27** in the Amendment After Final Filed on **06.15.2009**.

The amendment filed on **08.13.2009** has been considered. Applicants added new **claims 28-39**.

Therefore, **claims 1-8, and 21-39** remain pending in this application.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3687

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1, 2, 8, 21-23, and 27-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Staib et al. [2005/0222961] in view of Silverstein et al. [US 2004/0093281].

**As per claims 1 and 8**, Staib teaches a terminal for conducting a financial transaction [see at least paragraph 8 (e.g. **a payment terminal**)], comprising:

- a radio frequency reader, said reader configured to read a selected one of a plurality of payment tokens [see at least paragraph 8 (e.g. **Contactless payment can be enabled using a variety of technologies and tokens. Radio frequency (RF) technology has been used for most of the contactless payment initiatives**)] employing dissimilar data formats, and to provide data corresponding to an elicited response from said selected one of a plurality of payment tokens employing dissimilar

data formats [see at least paragraph 22 (e.g. ***data exchange formats used by those payment systems***)];

- a memory for recording data and a machine-readable program, said memory in communication with said radio frequency reader [as illustrated in figure 2, via memory 15, and see paragraph 38 (e.g. the smart mobile device 10 is a mobile telephone containing a CPU 14, an input device 20 such as a keypad connected to the CPU and a ***memory 15 storing a mobile application 2 and the stored value (digital cash) which is stored in a secured area of the memory 15***)];

- a processor module in communication with said memory and said radio frequency reader, said processor module configured by said machine-readable program to attempt to decode said data corresponding to said elicited response [see at least paragraph 38 (e.g. A communication module (NFC) 16 connected to the CPU 14 includes a communication chip and may also contain its own ***processor for handling data encryption and the like***), and paragraph 43, via processor 14], and paragraph 51 (e.g. ***processor 14 and is capable of reading the currency stored in the mobile device 22***)]; and

- wherein, responsive to an indication that said processor module is not configured to perform said decoding correctly, said communication module is configured to request from said remote computer-based apparatus at least one machine-readable instruction for properly configuring said processor module to decode said data [see at least paragraph 67 (e.g. ***merchant 22 can decode or decrypt the merchant***

**confirmation message which contains payment status information such as approval code, user number (e.g., mobile serial number) and the like)].**

Staib discloses all elements per claimed invention as explained above. Staib further discloses a remote charge and recharge of stored value in the smart mobile device [as illustrated in figure 8, and see paragraph 32], to download from a remote client server [see paragraph 76], and a communication module in communication with said radio frequency reader and said memory [see at least the abstract].

Staib does not explicitly disclose said communication module configured to communicate bidirectionally with a remote computer-based apparatus; and an output device for confirming a transaction register. However, Silverstein discloses in figure 17b a remote purchasing system incorporating RFID technology, and figure 1 of Silverstein also provides a graphic overview of the system architecture of an exemplary remote **purchasing system 100** [see paragraph 71]; and an output device for confirming a transaction register [see at least paragraph 233 (e.g. **input/output** access to the invention may comprise appropriate hardware and software (e.g., personal and/or mainframe computers provisioned with Internet wide area network communications hardware and software))].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teaching of Silverstein to the teaching of Staib in order to provide additional benefits, e.g., freeing consumers from carrying cash into venues, reducing transaction fees and financial risk for venues, and

increasing branding opportunities for manufacturers, distributors and third-party marketers [see summary of the invention].

**As per claim 2**, Staib teaches a transaction register [see at least paragraph 37 (e.g. *Computers 100 at merchant locations 22 are connected to contactless reader (contactless communicator) 12 at the point of sale which are adapted to communicate with smart mobile devices 10 for facilitating purchase transactions*)].

**As per claim 21**, Staib discloses wherein the terminal is configured to read a payment token employing a data format particular to a specific commercial entry [see at least paragraph 16 (e.g. *commercial operation*), and paragraph 22 (e.g. *data exchange formats used by those payment systems*)].

**As per claim 22**, Staib discloses wherein the terminal is configured to read a data format employing a data format particular to a specific retailer [see at least paragraph 40 (e.g. *a merchant application software 39 at the retail location 22*), and paragraph 22 (e.g. *data exchange formats used by those payment systems*)].

**As per claim 23**, Staib discloses wherein the terminal is configured to read a payment token provided by a key fob [see at least paragraph 12 (e.g. *low-frequency RFID payment is the key fob or key chain device*)].

**As per claim 27**, Staib discloses wherein the plurality of payment terms is issued by a plurality of commercial entities [see at least paragraph 49 (e.g., *separate entity that has an existing agreement to handle all financial aspects of the contactless payment transactions*)].

6. **Claims 3-7, and 24-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Staib in view of Silverstein as applied to claims 1, 2, and 8 above, and further in view of Metzger [US 2004/0186760].

**As per claims 3-7, and 24-26**, the combination of Staib and Silverstein does not explicitly teach wherein said transaction register is operated by a salesperson; the terminal comprising a printer; wherein said printer is configured to print a transaction receipt; an imaging device, wherein the imaging device comprises a bar code reader; the terminal is capable of capturing an area electronic image representation; and the terminal comprises a signature capture pad.

However, Metzger teaches wherein said transaction register is operated by a salesperson [see at least paragraph 5]; the terminal comprising a printer, and wherein said printer is configured to print a transaction receipt [see at least paragraph 25 (e.g. **a printer is also provided with the device for printing a receipt or other record of the transaction**)]; and an imaging device, wherein the imaging device comprises a bar code reader [see at least paragraph 25 (e.g. a magnetic-strip reader is coupled to the device)]; the terminal is capable of capturing an area electronic image representation [see at least paragraph 45 (**selectable logo image**)]; and the terminal comprises a signature capture pad [see at least paragraph 30 (e.g. **authorization signature**), and paragraph 35 (e.g. **A signature may be captured for transactions**)].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teaching of Metzger to the teaching of the combination of Staib and Silverstein in order to provide a portable device

for completing remote point of sale (POS) transactions [see summary of the invention, paragraph 11].

**Claims 28-39** are in parallel with the limitations presented in **claims 1-8, and 21-27** above, and recite the same limitations. Therefore **claims 28-39** are rejected under the same rationale, and the same basis.

### ***Response to Arguments***

7. Applicants' arguments with respect to **claims 1-8, and 21-39** have been considered but are moot in view of the new ground(s) of rejection.

In response to all of the limitations which Applicants dispute as missing in the applied references, including the newly added features in the **08.13.2009** amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of **Staib, Silverstein and Metzger** based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action, and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the

references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately. The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

### ***Conclusion***

8. The following prior art made of record and not relied upon is considered pertinent to Applicants' disclosure:

**Gomez et al. Pub. No.: US 2005/0165784**, teaches an information content files, such as text files, image files, XML files and the like, that provide information related to an identifier bearing item, such as a consumer item with a barcode, are stored on a data storage device such as network server. Identifier data entries, such as UPC data, are associated with file data entries, such as file names, in a database.

**Contact Information**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARCIA ADE whose telephone number is (571)272-5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571.272.3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a SPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Garcia Ade/  
Examiner, Art Unit 3687

Garcia Ade  
Examiner  
Art Unit 3687